



Docket No.: 237990US26



COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

ATTORNEYS AT LAW

RE: Application Serial No.: 10/821,900

Applicants: Marc RAMET

Filing Date: April 12, 2004

For: DEVICE FOR APPLICATION OF A LINE

Group Art Unit: 3751

Examiner: LE, HUYEN D.

SIR:

Attached hereto for filing are the following papers:

Provisional Election of Species

Our check in the amount of **\$0.00** is attached covering any required fees. In the event any variance exists between the amount enclosed and the Patent Office charges for filing the above-noted documents, including any fees required under 37 C.F.R. 1.136 for any necessary Extension of Time to make the filing of the attached documents timely, please charge or credit the difference to our Deposit Account No. 15-0030. Further, if these papers are not considered timely filed, then a petition is hereby made under 37 C.F.R. 1.136 for the necessary extension of time. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

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DOCKET NO: 237990US26



IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF :
MARC RAMET : EXAMINER: LE, HUYEN D.
SERIAL NO: 10/821,900 :
FILED: APRIL 12, 2004 : GROUP ART UNIT: 3751
FOR: DEVICE FOR APPLICATION OF A :
LINE

PROVISIONAL ELECTION OF SPECIES

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

SIR:

In response to the Election of Species Requirement dated July 6, 2006, Applicant provisionally elects with traverse Species II, Figures 4-9, and sub-species A, Figure 4,¹ and lists Claims 1-8, 10-31, 33-49, 55-64 and 67-83 as readable thereon and Claims 1-6, 8, 21-29, 31, 44-49, 55-63 and 67-73 as generic. Applicant is entitled to consideration of claims, directed to additional non-elected species, which include the limitations of an allowable generic claim, as provided by 37 C.F.R. 1.141(a).

Applicants respectfully traverse the election requirement for the following reasons.

The Election of Species Requirement includes the conclusory statement that "[t]his application contains claims directed to ... patentably distinct species ..." and lists two species and three sub-species. However, the Election of Species Requirement fails to state any basis in support of the finding that the identified species are patentably distinct. The requirement

¹ Species II identifies Figs. 4-9, but the sub-species do not list Figs. 5-7. Based on the specification, it is clear that Figs. 4-7 and 10 describe the same embodiment and thus should be considered as part of the elected sub-species A. See, for example, the specification from page 7, paragraph [0049] to page 9, paragraph [0055].

merely states that the species “include patently different structures,” without identifying which structures are patently different and why. This is contrary to MPEP §814, which states:

“The Examiner must provide a clear and detailed record of the restriction requirement to provide a clear demarcation between restricted inventions so that it can be determined whether inventions claimed in a continuing application are consonant with the restriction requirement and therefore subject to the prohibition against double patenting rejections under 35 U.S.C. 121. *Geneva Pharms. Inc. v. GlaxoSmithKline PLC*, 349 F.3d 1373, 1381, 68 USPQ2d 1865, 1871 (Fed. Cir. 2003). See also MPEP §804.01.

The mode of indicating how to require restriction between species is set forth in MPEP §809.02(a). The particular limitations in the claims and the reasons why such limitations are considered to support restriction of the claims to a particular disclosed species should be mentioned to make the requirement clear.”

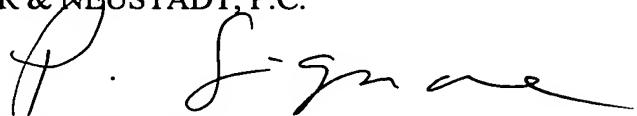
In particular, Applicant notes that each of the embodiments corresponding to the identified species I and II includes two arms mounted on a grasping element via a junction; and an applicator between the two arms, wherein at least one of the two arms or the junction is at least partially elastically deformable. It is not clear to Applicant what structure of the embodiments are patently different.

In the absence of any annunciated basis, it is respectfully submitted that the Election of Species Requirement fails to establish distinctness and the Applicant cannot fully address the Office’s conclusion and cannot fully consider whether or not the different species are indeed patentably distinct.

Therefore, Applicants respectfully request that the requirement to elect a single disclosed species be reconsidered and withdrawn,² and that a full examination on the merits of Claims 1-83 be conducted.

Respectfully submitted,

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²See MPEP 821.01.